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Paper No. 22  
TEH

10/30/00

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**  
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**Trump Taj Mahal Associates**  
v.  
**Chatam International Incorporated**  
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Opposition No. 111,896  
to application Serial No. 75/342,541  
filed on August 18, 1997  
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W. Mack Webner of Sughrue, Mion, Zinn, Macpeak & Seas, PLLC  
for **Trump Taj Mahal Associates**.

Arthur H. Seidel of Seidel, Gonda, Lavorgna & Monaco, P.C. for  
**Chatam International Incorporated**.  
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Before **Simms, Seeherman and Holtzman**, Administrative Trademark  
Judges.

Opinion by **Holtzman**, Administrative Trademark Judge:

An application has been filed by Chatam International  
Incorporated to register the mark XANADU for "wines and  
distilled spirits."<sup>1</sup>

Registration has been opposed by Trump Taj Mahal  
Associates under Section 2(d) of the Trademark Act. As its

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<sup>1</sup> Application Serial No. 75/342,541 filed August 18, 1997 alleging a  
bona fide intent to use the mark in commerce.

ground for opposition, opposer asserts priority and likelihood of confusion under Section 2(d) of the Trademark Act, contending that applicant's mark when applied to applicant's goods so resembles opposer's previously used mark XANADU for its "entertainment services, namely a nightclub and restaurant" as to be likely to cause confusion. Opposer has alleged use of its mark for the identified services at least as early as April 2, 1990 and has also pleaded ownership of a pending application for that mark in connection with the same services.

Applicant, in its answer, denies the salient allegations in the notice of opposition. Applicant also asserted that opposer's mark is entitled to a limited scope of protection in view of the suggestive nature of the mark and the third-party usage of the mark.

The record includes the pleadings; the file of the involved application; evidence by both parties made of record by notice of reliance including a status and title copy of the registration which issued from opposer's pleaded application; and the testimony with exhibits of opposer's Vice President, Stephanie Nielson.<sup>2</sup> Both parties filed briefs, but an oral hearing was not requested.

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<sup>2</sup> Applicant did not attend the deposition of this witness.

The record shows that opposer operates a nightclub and restaurant under the mark XANADU at the Trump Taj Mahal Hotel and Casino in Atlantic City, New Jersey. Applicant is a bottler and blender of alcoholic beverages, selling its products to distributors who in turn sell to retail outlets such as liquor stores, as well as to restaurants, bars and nightclubs.

Opposer has made of record a status and title copy of the registration which issued from its pleaded application.<sup>3</sup> Thus, there is no issue with respect to opposer's priority. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Applicant has not argued otherwise and, in any event, the evidence demonstrates opposer's use of XANADU in connection with restaurant and nightclub services prior to the August 18, 1997 filing date of defendant's application which is the earliest date on which defendant is entitled to rely.

This brings us to the issue of likelihood of confusion. Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to

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<sup>3</sup> Registration No. 2,177,705 issued August 4, 1998 for the mark XANADU for "entertainment services, namely, a nightclub and restaurant." Although the registration was not pleaded in the notice of opposition inasmuch as it issued after the commencement of this proceeding, applicant has not objected to opposer's reliance on the registration. In view thereof, the pleadings are hereby deemed to be amended in

the factors bearing on the likelihood of confusion issue. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In making this determination, the Board is mindful that in particular cases, a single du Pont factor may be dispositive in a likelihood of confusion analysis. See, e.g., Kellogg Co. v. Pack'em Enterprises, Inc., 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

We turn first to the parties' respective goods and services, and we begin by noting that the likelihood of confusion may result from the use by different parties of the same or similar marks in connection with goods, on the one hand, and services which deal with or are related to those goods, on the other. See In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467 (TTAB 1988) and Steelcase Inc. v. Steelcare Inc., 219 USPQ 433 (TTAB 1983). The question, then, is whether opposer's nightclub/restaurant services and applicant's wine and distilled spirits are sufficiently related and/or whether the circumstances surrounding the marketing of those goods and services are such that purchasers encountering them would, in view of the similarity of the marks, mistakenly believe that the goods and services emanate from the same source. Flow Technology Inc. v. Picciano, 18 USPQ2d 1970 (TTAB 1991) and Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590 (TTAB 1978).

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accordance with Fed. R. Civ. P. 15(b) so as to conform to the

Even if the marks are identical, if these conditions do not exist, we have held that confusion is not likely to occur. See, for example, *Borg-Warner Chemicals, Inc. v. Helena Chemical Company*, 225 USPQ 222 (TTAB 1983) and *Chase Brass & Copper Co., Incorporated v. Special Springs, Inc.*, 199 USPQ 243 (TTAB 1978).

We do not find the respective goods and services to be related. Opposer has introduced evidence that opposer's XANADU nightclub/restaurant sells at least two brands of alcoholic beverages produced by applicant under the names Chambord Liqueur and Devonshire Irish Cream Liqueur. Based on this evidence, and the fact that nightclubs and restaurants are normal channels of trade for alcoholic beverages, opposer asserts that applicant "is likely to want to sell its XANADU brand distilled spirits to [opposer]." (Opposer's brief, p.8).

There is no dispute that wines and alcoholic beverages are commonly served in nightclubs and restaurants in general, and that such beverages are in fact available to patrons of opposer's establishment. Thus, the channels of trade and classes of purchasers for these goods and services may overlap, but only to the extent that nightclub patrons can obtain a poured alcoholic beverage or glass of wine to be

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evidence.

consumed on the premises of the nightclub. However, nightclubs and similar establishments are not normal channels of trade for bottled wines and packaged distilled spirits which must, instead, be purchased at a liquor store or some other retail outlet for those products.

In any event, the fact that particular goods and services move through the same channels of trade to the same classes of purchasers does not, in and of itself, establish that such goods and services are related or that their sale under similar or even identical marks would be likely to cause confusion. See *Champion International Corporation v. Genova, Inc.*, 199 USPQ 301 (TTAB 1978). Products are not automatically deemed "related" to restaurant services merely by virtue of the fact that a patron could eat, drink or use them in a nightclub or restaurant. In a closely analogous situation, our primary reviewing court has rejected any per se rule that food products and food services are related merely by virtue of their complementary use or nature. See *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993). To establish a likelihood of confusion between those products and services, the Court has held that a party must show "something more" than that similar or even identical marks are used for these products and services. *Lloyd's Food Products Inc.*, supra and *Jacobs v. International*

Multifoods Corporation, 212 USPQ 641 (CCPA 1982). The element of "something more" is demonstrated, for example, where the food item served in the restaurant is of the type which may typically be packaged for retail sale by the restaurant under the same name, such as house specialty products.<sup>4</sup> See *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988). In the present case, opposer has submitted no evidence whatsoever to show that restaurants typically, or for that matter, ever package wine or alcoholic beverages for retail sale under their own marks; nor has opposer provided any other evidence which may be probative of consumer perception.

Opposer appears to assert that the mere fact that applicant's XANADU wine and distilled spirits may be sold in opposer's nightclub/restaurant will cause the relevant public to assume there is an association between those goods and services.<sup>5</sup>

However, opposer cannot prove the likelihood of confusion by, in fact, creating that confusion. Thus, we do not find that

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<sup>4</sup> In the *Mucky Duck* case, the Board noted that restaurants sometimes market their house specialties including items such as salad dressings through retail outlets.

<sup>5</sup> Specifically, opposer argues that "[t]he customers of the XANADU Showroom [sic], the customers of the [sic] Trump's hotel and casino and the purchasers of distilled beverages who will have heard of Trump's XANADU Showroom will be likely, upon seeing Applicant's distilled spirits for sale at the hotel, in the XANADU Showroom or in liquor stores wherever they may be, are likely to believe that there

purchasers who come in contact with applicant's wines or distilled spirits, even if under an identical mark as the nightclub/restaurant services, would expect the same companies which operate the nightclubs or restaurants to sell wine or alcoholic beverages.

We turn then to the marks. It is obvious that the parties marks are identical. Applicant does not dispute this point but rather contends that opposer's mark is suggestive and weak and, thus, entitled only to a narrow scope of protection. To demonstrate the suggestive nature of the mark and the public's familiarity with the term, applicant has made of record an encyclopedia reference describing "Xanadu" as a province or region in China "mentioned" in Samuel Coleridge's poem, "Kubla Khan" as the site of Khan's well-known pleasure garden. Applicant has also submitted a dictionary definition referring to

"Xanadu" as "a place of great beauty, luxury, and contentment."<sup>6</sup> Applicant has also included passages from the

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is an association between Trump and the Applicant when there is none." (Opposer's brief, p.8).

<sup>6</sup> We note that opposer has objected to applicant's notice of reliance on these materials as well as to the dictionary and encyclopedia references submitted by applicant on the ground that applicant failed to comply with Trademark Rule 2.122(e) by stating the relevance of each of these materials in its notice of reliance. We do not condone applicant's failure to comply with the rule. However, a procedural



poem itself as it appears in a dictionary of quotations and three publications in the nature of movie and video review guides containing descriptions of a 1980 film entitled "Xanadu." It can be seen from this evidence that XANADU is not an arbitrary or fanciful mark in the context of opposer's services. The evidence shows that when XANADU is used in connection with a nightclub and restaurant the term is in fact suggestive of the environment or ambiance for those services.

However, applicant's claim of "enormous third party usage" of XANADU for restaurants and/or related products must fail. Applicant has submitted evidence consisting of summaries obtained from a private search company of twelve third-party registrations and two (abandoned) applications which comprise the term "XANADU," a listing of 72 business names incorporating "Xanadu" taken from the Dialog database, and a listing of 14 businesses obtained from a Dun & Bradstreet report. Opposer has objected to the admissibility of these

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objection of this nature to a notice of reliance should have been raised promptly, preferably by motion to strike since this ground for the objection is, contrary to opposer's claim, one which could have been cured if raised in a prompt manner. See *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992) and generally TBMP § 718.02(b). Accordingly, this objection is overruled and we will consider the materials submitted with the notice of reliance as part of the record. In any event, it is obvious that by this evidence applicant is attempting to show the suggestive meaning of the term "Xanadu."

materials on the basis that they have not been properly introduced in evidence.<sup>7</sup>

Opposer's objections to these materials are well taken.<sup>8</sup> The summaries of third-party registrations and applications provided by applicant are inadmissible. They obviously do not constitute official records within the meaning of Trademark Rule 2.122(e) since they were obtained from a private search company;

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<sup>7</sup> In addition, applicant has improperly relied on *Lloyd's Food Products., Inc. v. Eli's, Inc.*, supra, to support its position that the Dialog and Dun & Bradstreet evidence is probative of third-party use. Unlike telephone or advertising directories, neither the Dialog listing of business names nor trade materials such as the Dun & Bradstreet report are directed to the purchasing public or are in any way used in the "sale" or "advertising" of services within the meaning of that case.

<sup>8</sup> Opposer's objection to applicant's notice of reliance on documents which were obtained during discovery through applicant's document requests is also well taken. Although applicant identified these documents in its notice of reliance as "printed publications" under Trademark Rule 2.122(e), in fact they consist of what appear to be a third-party advertisement or brochure for a tea called "Xanadu" and copies of promotional materials for opposer's nightclub. None of these materials is appropriate subject matter for submission by means of a notice of reliance under Trademark Rule 2.122(e) and thus has not been considered. Printed publications, which may be introduced in evidence by notice of reliance, include books and periodicals available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant to an issue in a proceeding. See *Andrea Radio Corporation v. Premium Import Co., Inc.*, 191 USPQ 232 (TTAB 1976). The burden of showing public availability, where there is doubt, lies on the proponent of the evidence. Private promotional literature is not presumed to be publicly available in the sense of being readily accessible for inspection in libraries open to the public or of such currency that the other party is presumably familiar with it. See *Glamorene Products Corporation v. Earl Grissmer Company, Inc.*, supra. To the extent that some of opposer's promotional materials which were

nor do they qualify as printed publications under that rule. See *Weyerhaeuser Co. v. Katz*, supra (a notice of reliance on search reports available only from private enterprises at a fee was held improper); and *Glamorene Products Corporation v. Earl Grissmer Company, Inc.*, 203 USPQ 1090 (TTAB 1979).

On the other hand, while the extent of opposer's use does not appear to be "trivial," as alleged by applicant, opposer's asserted "fame" of its mark has not been established.

(Opposer's brief, p.13). The record shows that opposer has operated its XANADU nightclub and restaurant since 1995, a period of only five years,<sup>9</sup> and features the performances of such entertainers as Don Rickles, Neil Sedaka, Natalie Cole, Smokey Robinson and Buddy Hackett, as well as musical revues and full-length musical productions. Opposer's advertising and promotional activities are conducted through such media as newspaper, radio and direct mailings (to a list of over 150,000 people) and are concentrated primarily in the areas of Philadelphia, northern New Jersey and Delaware. Over a five year period, the establishment has generated nearly \$3.8 million in revenue

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submitted by applicant were properly made of record in connection with the testimony of Ms. Nielson, that material has been considered.

<sup>9</sup> Opposer in fact claims that its nightclub has been in existence since 1990, but there is no proof of use earlier than 1995 in the record.

(which amounts to less than \$1 million per year) and opposer has spent a total of approximately \$575,000 in advertising and promoting its

services.<sup>10</sup> In addition, over 750,000 people have attended performances at the nightclub during that period.

The nightclub appears to have achieved some measure of regional success and recognition. However, the figures provided by opposer do not appear extraordinary on their face, and without any context for the figures, such as the nightclub's reputation in the industry, its share of the relevant market, or some other basis for comparison with the rest of the industry, their significance cannot be meaningfully assessed. In other words, there is nothing in the record to suggest that opposer's sales, for example, reflect anything more than typical revenue for similar establishments offering similar entertainment. See, for

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<sup>10</sup> Opposer asserts that its advertising expenditures "[have] exceeded one million dollars over the last five years." (Opposer's brief, p.5 and Nielson test. p.21). However, Ms. Nielson testified that annual expenditures for advertising "[have] been in excess of 75 thousand per year" over a five-year period and that, in addition, opposer has spent "in excess of 40 thousand annually" for direct mail advertising during the same period. (Nielson test. pp.20-21). By our calculations, advertising expenditures over the five-year period would total \$575,000, not one million dollars.

example, *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400 (TTAB 1998).

In view of the foregoing and the suggestive quality of the mark in connection with opposer's nightclub and restaurant, we find the mark is, at best, only moderately strong as used in connection with those services and, as such, entitled to a more limited scope of protection than an arbitrary or fanciful mark. Since opposer has provided no persuasive evidence that wines and distilled spirits on the one hand and nightclubs or restaurants on the other are related goods and services, the protection of opposer's XANADU mark should not extend beyond opposer's nightclub and restaurant services to wine and distilled spirits.<sup>11</sup>

Thus, we find that the contemporaneous use of the marks in connection with the respective goods and services is not likely to cause confusion.<sup>12</sup>

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<sup>11</sup> As a final note, opposer's suggestion that applicant intentionally adopted its XANADU mark to trade directly on the goodwill of opposer is unsupported. It is true that the person responsible for selecting the word XANADU as applicant's mark, Mr. Kevin O'Brien, stated, in response to a request for admission, that he had "[stayed] overnight" at the Trump Taj Mahal Casino Resort "prior to August 8, 1997" that is, at some time prior to the filing of the involved application. However, there was no request for Mr. O'Brien to admit that he was aware of the XANADU nightclub during that visit and moreover, there is no particular time frame for that visit; it could have occurred prior to the time the nightclub was in existence.

**Decision:** The opposition is dismissed.

R. L. Simms

E. J. Seeherman

T. E. Holtzman  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board

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<sup>12</sup> The cases relied on by opposer are not persuasive of a different result. The BEEFEATER cases (including *James Burrough Ltd. v. Leshner*, doing business as Beefeater's, 309 F.Supp. 1154, 163 USPQ 208 (D.C. Ind. 1969) and *James Burrough Limited, et al. v. Sign of the Beefeater, Inc.*, 540 F.2d 266, 192 USPQ 555 (7<sup>th</sup> Cir. 1976)) were decided on the basis of such findings, among others not present here, that the BEEFEATER mark is unique and arbitrary, that the mark is famous as applied to gin, and that there has been substantial use of the mark for over a century. As we have noted above, the record in the present case falls far short of establishing that opposer's XANADU mark is famous. The case of *Death Tobacco Inc. v. Black Death USA*, 31 USPQ2d 1899 (D.C. Cal. 1993) is equally inapplicable. In that case, the Court found that the respective products (vodka and cigarettes) "are clearly related in consumers' minds" in view of the "unique and sensational" nature of the mark and the way the products were sold and marketed together in package stores. In the present case, opposer has failed to show that the respective goods and services are related in consumers' minds or that its mark is unique. Moreover, while it could be said that nightclubs and alcohol are complementary products and services, there is no evidence that nightclubs or restaurants promote or even sell brands of alcohol under the restaurant mark or that retail outlets such as liquor stores promote alcohol and nightclubs/restaurants together under the same mark.